

REMARKS

The Office Action dated October 28, 2003, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 11-13 have been amended. No new matter has been added. Claims 2, 6, 9, 11-20, 22-23, 25-29 and 33-35 are pending and respectfully submitted for consideration.

The Abstract was objected to for containing the word "read" in line 8. The Applicant submits that the substitute Abstract filed on April 18, 2003, does not contain the word "read". Accordingly, the Applicant respectfully requests withdrawal of the objection.

Claims 14, 28, 29, 33, 9, 27, 2, 6, 22, 23, 25, 26, 34, and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller (U.S. Patent No. 6,450,500 B1) in view of Nazarayan et al. (U.S. Patent No. 5,772,211). Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Nazarayan further in view of Woodland et al. (U.S. Patent No. 5,632,485, "Woodland"). Claims 19 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miller in view of Nazarayan in view of Woodland, further in view of Sines et al. (U.S. Patent No. 6,270,404 B2, "Sines"). Each of the rejections noted above cite the combination of Miller and Nazarayan. The Applicant traverses these rejections and respectfully submits that the combination of Miller and Nazarayan does not support a *prima facie* case of obviousness.

To this end, the Applicant submits a Declaration under 37 C.F.R. §1.132. In this Declaration, the Applicant has provided the expert opinion of Mr. Brian Hansen, a table games manager at the Isle of Capri Casino in Colorado. Mr. Hansen attests that the combination of Miller and Nazarayan fails to disclose to suggest the claimed features of the invention. Specifically that Miller and Nazarayan fail to disclose or suggest receiving from each of the at least one player a selection of a dealer hand characteristic for the auxiliary game, wherein the dealer hand characteristic is selected from a group consisting of at least two of the dealer hand being all red, the dealer hand being all black, the dealer hand totaling an even number, the dealer hand totaling an odd number, the dealer hand consisting of two cards, the dealer hand consisting of three cards, the dealer hand consisting of four cards, the dealer's hand consisting of five cards, the dealer's hand consisting of six cards, and the dealer's hand consisting of seven cards, as claimed in claim 14 and as similarly claimed in claims 15, 28, 29, and 33-35.

Under U.S. patent practice, the PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See also In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002). The Office Action restates the advantages of the present invention to justify the combination of references. There is, however, nothing in the applied references to evidence the desirability of these advantages in the disclosed structure. Further, the combined references do not disclose or suggest the features of the invention as recited in the claims.

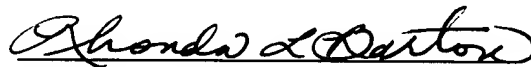
In view of the above, the Applicant respectfully submits that the Office Action has failed to establish a *prima facie* case of obviousness for purposes of a rejection of claims 2, 6, 9, 11-20, 22-23, 25-29 and 33-35 under 35 U.S.C. §103.

For at least the combination of foregoing reasons the Applicant respectfully submits that Miller, Nazarayan, Woodland, and Sines, either singly or in combination fails to disclose or suggest the present invention as claimed in claims 14, 15, 28, 29 and 33-35 and are therefore allowable. Also, the remaining claims 2, 6, 9, 11-14, 16-20, 20-23, and 25-27 depend from these allowable claims, are likewise allowable. Accordingly, the Applicant respectfully requests allowance of claims 2, 6, 9, 11-20, 22-23, 25-29 and 33-35, and the prompt issuance of a Notice of Allowability.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any additional fees that may be due with respect to this paper, may be charged to counsel's Deposit Account No. 01-2300, **referencing Attorney Dkt. No. 026066-00003**

Respectfully submitted,



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RLB/wbp

Enclosure: Declaration under 37 C.F.R. §1.132
Petition for Extension of Time (1-month)